

REMARKS

The Office Action outlines the following issues:

The restriction requirement of June 6, 2003 has been withdrawn;

The drawings stand objected to for informalities;

Claim 14 is objected to for informalities;

Claim 13 is rejected under 35 U.S.C. § 112, first paragraph;

Claims 1 and 4 are rejected under 35 U.S.C. § 112, second paragraph;

Claims 1 and 5-8 are rejected under 35 U.S.C. § 102(e); and

Claims 2-4, 9-12, and 14-20 are rejected under 35 U.S.C. § 103.

This response amends three paragraphs of the specification to correct minor typographical errors, amends claims 4 and 14 to clarify the claimed invention, and amends FIGURES 2 and 4 to correct two minor errors. No new matter has been added. Claims 1-20 remain pending in the present application.

Claims 6 and 13 do not stand rejected by the Office Action, and the Applicants respectfully request that the Examiner indicate claims 6 and 13 as containing allowable subject matter.

I. Amendments

The specification has been amended at pages 9, 12, and 13. At pages 9 and 12, “of FIGURE 1” has been added to clarify the location of “host agent 111.” At page 13, two typographical errors have been corrected; the ROM of FIGURE 4 is now correctly identified as 404, and the I/O controller card of FIGURE 4 is now correctly identified as 405. In FIGURE 4, the mouse has been given the corrected reference number 407. No new matter has been added by these amendments. The Applicants believe that these amendments traverse the Office Action’s objections to the figures, and respectfully request that the objections to the specification and the figures be withdrawn.

Claim 14 has been amended as suggested by the examiner to insert “an” between “creating” and “object”. The Applicants respectfully request that the objection to claim 14 be withdrawn.

Claim 4 has been amended to insert “said device information” after “step of retrieving” to clarify the claimed invention. The Applicant believes this amendment traverses the Office Action’s 35 U.S.C. § 112 rejection of claim 4, and respectfully requests that it be withdrawn.

II. Rejections Under 35 U.S.C. § 112, First Paragraph

Claim 13 is rejected for containing subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains to make or use the invention. However, “[t]o establish a reasonable basis for questioning the adequacy of a disclosure, the examiner must present a factual analysis of a disclosure to show that a person skilled in the art would not be able to make and use the claimed invention without resorting to undue experimentation.” *See* M.P.E.P. § 2106.02. The Applicants respectfully submit that the Office Action fails to present such a factual analysis. Further, the Applicants respectfully disagree with the assertion that application programming interface (API) requires description to enable its use by one of ordinary skill in the art. “As a general rule, where software constitutes part of a best mode of carrying out an invention, description of such a best mode is satisfied by a disclosure of the functions of the software . . . [t]his is because, normally, writing code for such software is within the skill of the art.” M.P.E.P. § 2106.01 citing *Fonar Corp. v. General Electric Co.*, 107 F.3d 1543 (Fed. Cir. 1997). API software is well known in the art as an application to facilitate a device interface. Its function with regard to claim 13 is sufficiently detailed in the specification to enable its use by one of ordinary skill in the art. Therefore, the Applicants respectfully request that the 35 U.S.C. § 112 rejection of claim 13 be withdrawn.

III. Rejections Under 35 U.S.C. § 112, Second Paragraph

The Office Action rejects claim 1 opining that “retrieving a property file defining a type of device” is a narrow range limitation that falls within the broad range limitation of “retrieving device information from a device associated with said I/O path utilizing a device

control protocol.” The Applicants respectfully submit that the two retrieving steps of claim 1 are not a broad and a narrow range of a single limitation, but are in fact elements of separate limitations. As the specification explains at page 8, a “property file” and “device information from a device associated with said I/O path” come from different locations, and may or may not contain overlapping information. Therefore, the rejection of claim 1 is improper and should be withdrawn.

The Office Action rejects claim 4 for failing to provide sufficient antecedent basis for “said step of retrieving.” The Applicants have amended claim 4, traversing the rejection. The Applicants respectfully request that rejection of claim 4 be withdrawn.

IV. Rejections Under 35 U.S.C. § 102(e)

The Office Action rejects claim 1 as anticipated by Babu et al. US Patent No. 6,122,639 (hereinafter *Babu*). However, the Applicants respectfully submit that the rejection of record is improper. In order to anticipate claim 1, *Babu* must teach every element of claim 1, and must arrange each element as required by claim 1. See M.P.E.P. § 2131, citing *In re Bond*, 15 US.P.Q.2d 1566 (Fed. Cir. 1990). Claim 1 recites a method that determines “the type of device associated with an input/output path” by, in part, “retrieving device information from a device,” “retrieving a property file defining a type of device,” and “executing code associated with said property file, wherein said code is operable to determine whether said device is said type of device utilizing in part said retrieved device information.” *Babu* cannot anticipate claim 1, because *Babu* does not disclose “retrieving a property file,” and *Babu* does not disclose “executing code associated with said property file”. Further, *Babu* does not appear to disclose determining the type of a device through any defined method, but rather discloses merely “obtaining a device type identifier from the device.” See *Babu* column 2, lines 64-65. At column 3 lines 8-10 *Babu* does “[look] up the device type identifier in a device type table stored in the database,” and does “[raise] an exception when the device type identifier is not found.” However, these steps are not done “to determine whether said device is said type of device,” as argued by the Office Action on page 5, because when this step is performed in *Babu*, the device type has already been determined. *Babu* does not, therefore, disclose all of the elements of claim 1 arranged as required by claim 1. The Applicants respectfully request that the rejection of claim 1 be withdrawn.

Claims 2-6 depend directly or indirectly from claim 1, and therefore inherit all the limitations of claim 1. Because claims 2-6 contain limitations not disclosed by *Babu*, the Applicants respectfully submit that claims 2-6 are patentable over *Babu* and respectfully requests that the rejection of record be withdrawn.

The Office Action also rejects claim 7 as anticipated by *Babu*, but the Applicants respectfully submit that the rejection of claim 7 is also improper. Claim 7 recites a system that includes “code operable to determine whether said device associated with said I/O path is said type of device utilizing in part said device information obtained by said means for obtaining and information obtained from said means for defining.” *Babu* does not disclose any such code, but rather teaches merely “obtaining a device type identifier from the device.” At column 3 lines 8-10, *Babu* does “[look] up the device type identifier in a device type table stored in the database,” and does “[raise] an exception when the device type identifier is not found.” However, *Babu* does not do so “to determine whether said device is said type of device,” as argued in the Office Action at page 6, because at the time this step is performed in *Babu*, the device type has already been determined. *Babu* does not, therefore, disclose all of the elements of claim 7 arranged as required by claim 7, and the Applicants respectfully request that the rejection of claim 7 be withdrawn.

Claim 8 depends directly from claim 7, and therefore inherit all the limitations of claim 7. Because claim 8 contains limitations not disclosed by *Babu*, the Applicants respectfully submit that claim 8 is patentable over *Babu* and respectfully requests that the rejection of record be withdrawn.

V. Rejections Under 35 U.S.C. § 103(a)

The Office Action rejects claims 2-4, 9-12, and 14-20 as obvious. However, the Applicants respectfully submit that the Office Action has failed to establish a *prima facie* case for these rejections. In order to establish a *prima facie* case of obviousness, the Office Action is required to meet three basic criteria. *See* M.P.E.P. § 2143. First, the Office Action must articulate some suggestion or motivation to modify or combine the teachings of the cited references, and must find this suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Second, the indicated modification or combinations must have a reasonable expectation of success. Finally, the

cited references must teach or suggest all the claim limitations when combined. Without conceding the first or second criteria, the Applicants respectfully assert that the cited references do not teach or suggest all of the limitations in the rejected claims.

For Example, the Office Action rejects claims 2 and 3 as unpatentable over *Babu* alone, and also rejects claim 4 as unpatentable over *Babu* in light of Allen et al., published US Patent Application No. 2002/0161852 (hereinafter *Allen*). But as dependants of claim 1, claims 2 -4 inherit all of the limitations of claim 1, and as stated above, *Babu* does not teach all of the elements of claim 1. Because *Babu* does not teach each and every element of claim 1, the Applicants respectfully request that the Examiner withdraw the rejection of claims 2 and 3. Further, because *Allen* does not appear to teach the absent limitations either, the Applicant also respectfully requests that the Examiner withdraw the rejection of claim 4.

The Office Action also rejects claim 9 as being unpatentable over *Babu* alone. However, claim 9 recites a system that includes “code for calling a method of each instantiated object, wherein said method is operable to determine whether a device associated with said I/O path is the type of device defined by said data structure associated with said respective instantiated object of said method.” *Babu* does not disclose any such code, but rather teaches merely “obtaining a device type identifier from the device.” At column 3 lines 8-10, *Babu* does “[look] up the device type identifier in a device type table stored in the database,” but this step does not determine whether a device is the type of device defined by said data structure, as the Office Action apparently claims at page 7, because when that step is performed the device type has already been determined. *Babu* does not, therefore, teach every element of claim 9, and the Applicants respectfully request that the Examiner withdraw the rejection of claim 9.

Claims 10-13 depend directly or indirectly from claim 9, and thus inherit all of the limitations of claim 9. Because claims 10-13 each contain limitations not disclosed by *Babu*, the Applicants respectfully submit that claims 10-13 are patentable over *Babu*, and respectfully requests that the Examiner withdraw the rejection.

The Office Action also rejects claim 14 as unpatentable over *Babu* alone. However, claim 14 recites a method for discovering a type of device that includes the step of “calling a method of each created object, wherein said method is operable to determine whether a

device associated with said I/O path is the type of device described by the property file associated with the said object method.” *Babu* does not teach this element; *Babu* teaches merely “obtaining a device type identifier from the device.” *Babu* does “[look] up the device type identifier in a device type table stored in the database,” but this step does not determine whether the device is the type of device described by the property file associated with the said object method, as the Office Action apparently claims at page 8, because when this step is performed in *Babu*, the device type has already been determined. *Babu* does not, therefore, teach every element of claim 14, and the Applicants respectfully request that the Examiner withdraw the rejection of claim 14.

The Office Action rejects claims 15 and 17 as unpatentable over *Babu* alone, and rejects claim 16 as unpatentable over *Babu* in light of *Allen*. However, as dependants of claim 14, claims 15-17 inherit all of the limitations of claim 14, and as stated above, *Babu* does not teach all of the elements of claim 14. Therefore, the Applicants respectfully request that the Examiner withdraw the rejection of claims 15 and 17. Further, because *Allen* does not appear to teach the absent limitations either, the Applicant also respectfully requests that the Examiner withdraw the rejection of claim 16.

The Office Action rejects claim 18 as unpatentable over *Babu* in light of *Allen*. Claim 18 recites a system for analyzing input/output paths that includes:

a management server process, wherein said management server process is operable to receive gathered device information from said plurality of host agent processes and from said SNMP manager process; and wherein said management server process is operable to call code identified by property files with gathered device information as arguments to thereby identify types of devices associated with I/O paths of said SAN.

Babu does not teach such a management server. *Babu* does send “an SNMP Query For a system object identifier to the network . . . and [test] whether the device is discovered in the network,” but this step does not identify types of devices, as the Office Action apparently claims at page 10, because when this step is performed in *Babu*, the device type has already been determined. *Allen* does not appear to teach this element either, and indeed, the Office Action does not rely on it to do so. The combination of *Babu* and *Allen* do not, therefore,

teach every element of claim 18. The Applicants respectfully request that the Examiner withdraw the rejection of claim 18.

Claims 19 and 20 depend directly or indirectly from claim 18, and thus inherit all of the limitations of claim 18. Because claims 19 and 20 contain limitations not disclosed by *Babu* and *Allen*, the Applicants respectfully submit that claims 19 and 20 are patentable over *Babu* and *Allen*, and respectfully requests that the Examiner withdraw the rejection.

Although the motivation for combining the cited references have not been addressed, the Applicants do not concede that any of the combinations used in the Office Action are proper. The Applicants contend that the Office Action has failed to make a prima facie case for rejection of the pending claims under 35 U.S.C. § 103(a), therefore any specific arguments regarding motivation would be premature.

In the rejections of claims 2-4, 9-12, and 14-20, the Office Action states that various elements of the rejected claims are well known in the art. The Applicants have not specifically addressed these issues, because the Examiner has not as yet made a prima facie showing of obviousness. In light of the Examiner's statement that such teachings are well known, the Applicants believe that the Examiner has either relied on his own personal knowledge, or taken Official Notice, with respect to these matters. Under Rule 37 C.F.R. §1.104(d)(2), the Examiner is hereby requested to provide and make of record an affidavit setting forth his data as specifically as possible for the assertion. Alternatively, under M.P.E.P. §2144.03, the Examiner is hereby requested to cite a reference in support of these assertions. The Applicants reserve the right to contest these issues in subsequent papers. Otherwise the rejections of claims 2-4, 9-12, and 14-20 should be withdrawn.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025 Order No. 10004560-1 the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV256035540US, in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on the date shown below.

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Respectfully submitted,

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